

### **REMARKS**

By this amendment, claims 25-52 have been canceled, without prejudice, and claims 53-64 have been amended. Therefore, claims 53-64 are currently pending.

1. Response to Claim Objections for Claim Numbering

Applicant notes that originally presented claims 1-40 should have been numbered 25-64. The pending claims have been renumbered accordingly, to correspond to this new sequence.

2. Response to Election/Restriction

Claims 25-64 appear to be subject to a restriction requirement. Applicant acknowledges election of claims 53-64 with traverse. Applicant reserves the right to file a continuation application including claims directed to the non-elected species.

3. Response to Claim Objections of Claims 56-57, 61, and 64

Claims 56-57, 61, and 64 are objected to because of certain informalities regarding lack of antecedent basis. In response, these claims have been amended to resolve any inconsistencies with regard to antecedent basis references. It is therefore respectfully submitted that the instant claim objections claims 56-57, 61, and 64 have been overcome.

4. Response to Drawing Objections

The drawing are objected to under 37 C.F.R. 1.83(a). Specifically, with regard to the elements of “inner surface,” “outer surface,” “first surface area,” “second surface area” in claim

53, and “first portion of an injection molding die,” “second portion of the injection molding die,” and “injection molding surface” in claims 54-57.

With respect to the elements of the “inner surface” and “outer surface” recited in claim 53, the Examiner’s attention is drawn to elements 20 and 21 of Figure 1. The specification section that refers to this figure states that “the housing 11 has an outside surface 20 and an inside surface 21.” (“167 Application, Page 6, line 4). Therefore, it is respectfully submitted that the drawings show these elements of the claim.

With respect to the elements of a “first surface area” and a “second surface area,” claim 53 has been amended to recite a “viewing area” and a “substantially nontransparent area.” These are illustrated and described in Figure 1 as element 22 and the remaining portion of housing 11, respectfully. Thus, it is respectfully submitted that the instant objection to these claim elements is rendered moot.

With respect to the elements of the first and second portions of an injection molding die, and an injection molding surface, as recited in claims 54-57, as well as with respect to the drawing objection based on the fact that they fail to show an injection molding die as described in the specification and claims, Applicant respectfully submits that one of ordinary skill in the art would understand how to implement the techniques and methods of construction described in the specification, without need for further drawings. 35 U.S.C. §113 states that “the applicant shall furnish a drawing where necessary for the understanding of the subject matter to be patented.” It is submitted that the disclosure of forming a housing through the use of an injection molded die is sufficient to enable one of ordinary skill in the art, and that a drawing is not necessary to illustrate the manufacturing steps involved. Likewise, the element of forming the first and

second portions of the die are disclosed as being by etching, such as mechanical etching. One of ordinary skill in the art would understand this element without the need for further drawings.

5. Response to Claim Rejections Under 35 U.S.C. § 112, first paragraph

Claims 53-64 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

A, B) With regard to the rejections of claim 53 based on the elements of a “first surface roughness...is low enough to render the display element,” the “second surface roughness is greater than the first surface roughness,” claim 53 has been amended to recite a “viewing area” and a “substantially nontransparent area” in place of the first and second surface roughness areas, respectively. This conforms to language as used in the specification of the ‘167 application. Therefore, it is respectfully submitted that the instant claim rejection has been overcome.

C) The limitation stating “allow only diffuse light” has not been described in the specification. Claim 53 has been amended to recite that the substantially nontransparent are with a second surface treatment “scatters light diffusely” through the housing. This conforms the claim language to that used in the specification at the location cited by the Examiner (i.e., page 6, line 19).

Claim 54 stands rejected under 35 U.S.C. § 112, first paragraph on the basis that the limitation stating “etching a first portion of an injection molding die” has not been described in the specification; claim 55 stands rejected under 35 U.S.C. § 112, first paragraph on the basis that the limitation stating that “leaving a second portion of the injection molding die in an unetched

state has not been described in the specification; and claim 56 stands rejected under 35 U.S.C. § 112, first paragraph on the basis that the limitation stating that the first portion of the injection molding die is produced by mechanical etching of the injection molding surface has not been described in the specification.

With regard to these claims, Examiner's attention is brought to page 6 of the specification, which states that the housing is "produced in the first step in one piece from plastic material, in which the surface of the injection molding die is treated so that at least one of the surfaces of the part is structured ... it is conceivable to spare one part of the surface of the die of the housing 11 from treatment, for example by covering. Treatment of the die surfaces can occur mechanically or chemically. In the preferred practical example, the structured surface is produced by etching of the injection molding die surface." ('167 specification, page 6, lines 17-26). It is respectfully submitted that this passage contains adequate disclosure to support the cited claim elements. That is, the specification describes that the injection molding die surface can be etched, while one part is spared from etching by covering, for example. This clearly describes etching a first portion of a die while leaving a second portion unetched. Furthermore, the specification clearly states that the die surface can be treated mechanically, and that the structured surface can be produced by etching. It is respectfully submitted that one of ordinary skill in the art would understand this to mean that the die can be mechanically etched in one portion and left unetched in another portion to produce the claimed housing.

Claim 57 stands rejected under 35 U.S.C. § 112, first paragraph on the basis that the limitation stating that the first portion of the injection molding die is produced by chemical etching of the injection molding surface has not been described in the specification. As stated above, the specification of the '167 application states that "treatment of the die surfaces can

occur mechanically or chemically.” (‘167 application, page 6, line 24, emphasis added). In the same paragraph, applicant states that the structured surface is produced by etching. Therefore, it is respectfully submitted that adequate basis exists in the description to support the claim element of chemical etching of the injection molding die surface.

Claim 58 stands rejected under 35 U.S.C. § 112, first paragraph on the basis that the limitation stating “the first surface area is produced by polishing a sub-portion of the second surface area...” has not been described in the specification. Claim 58 has been amended to recite that the “viewing area is produced by polishing a sub-portion of the substantially nontransparent area.” Support for this claim can be found on page 6 of the ‘167 application, wherein it is stated that “the viewing area 22 can then be produced by polishing.” Therefore, it is respectfully submitted that the instant rejection under 35 U.S.C. § 112 has been overcome.

6. Response to Claim Rejections Under 35 U.S.C. § 112, second paragraph

Claims 53-54 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 53 is rejected under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections.

Claim 53 has been amended to recite a “substantially nontransparent area surrounding the viewing area.” Although the original claim stated that both areas were part of an integral (now unitary) housing, both areas were included within a single housing, thus containing their essential structural cooperative relationship. However, in the interest of advancing prosecution of the present application, applicant has amended the claim to recite exactly how the viewing area is

structurally related to the substantially nontransparent area. Support for this amendment is contained in Figure 1, which shows the viewing area 22 surrounded by the remaining portion of housing 14. Therefore, it is respectfully submitted that in light of the amendment, the instant under 35 U.S.C. 112, second paragraph, has been overcome.

With regard to claim 53, the Examiner states: “A) the claim language is confusing because it is not clear how the first surface area can have some roughness, and the second surface area has a greater roughness and ‘the electronic surface to be less visible’”; and that “B) the limitation stating “allow only diffuse light” makes the claim language confusing.” Claim 53 has been amended to recite a housing having a viewing area with a first surface treatment that allows the display element to be visible through the housing, and a substantially nontransparent area with a second surface treatment that scatters light diffusely through the housing and causes the electronic circuit to be less visible than the display element through the housing. It is respectfully submitted that in light of the amendments, the instant claim rejection has been overcome.

Claim 54 stands rejected under 35 U.S.C. § 112, second paragraph, as being confusing because it is not clear how the second surface area is produced by etching a first portion of an injection molding die and whether the transparent material should first be inserted in the die in order the second surface area to be produced. In response, claim 53 has been amended to recite that the substantially nontransparent area is produced by etching a first portion of the injection molding die, prior to injection of the transparent material in the die. Thus, it is respectfully submitted that the claim language now clearly recites that the first portion of the die was prepared by etching before the transparent material was placed into the die, as suggested by the Examiner.

Claim 55 stands rejected under 35 U.S.C. § 112, second paragraph, as being confusing because it is not clear how the second surface area is produced by leaving a second portion of the injection molding die in an un-etched state. In response, claim 53 has been amended to recite that the viewing area is produced by leaving a second portion of the injection molding die in an un-etched state, prior to injection of the transparent material in the die. Thus, it is respectfully submitted that the claim language now clearly recites that the second portion of the die was prepared by etching before the transparent material was placed into the die, as suggested by the Examiner.

In light of the amendments to claims 53, it is respectfully submitted that the instant rejection of dependent claims 54-64 has been overcome.

7. Response to Claim Rejections Under 35 U.S.C. § 103(a)

Claim 53 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Takagi (U.S. Patent No. 4,729,672) in view of Pallanes (U.S. Patent No. 5,975,724).

Takagi discloses an electronic clinical thermometer with a casing comprising a transparent inner case and an outer case body. The inner case body is molded using a multiple-color injection molding machine, and the outer case body is molded from an opaque resin so as to cover the outer surface of the inner case body. The outer case body is provided with a display window which is cut away to expose the transparent inner case so that a temperature display is visible therethrough. The inner case is tightly joined with the outer case to form a one-piece casing. (Takagi, Col. 5:24-26). However, the parts are molded separately so that the “distinctive characteristics of each of the plastics are unaffected.” (Takagi, Col. 6:28-29). Pallanes discloses

a convertible light shade made of an opaque material which an insert that may be translucent or clear.

By this amendment, claim 53 has been amended to recite an electronic thermometer comprising a unitary housing enclosing the electronic circuit and display element, and formed of a single piece of transparent material. (Amended claim 53, emphasis added). Neither Takagi nor Pallanes, either alone or in combination, teach or suggest an electronic thermometer in which a display area and substantially nontransparent area are contained within a unitary housing that is formed by a single piece of transparent material. Takagi teaches the construction of a thermometer with an inner case and an outer case. Though the resulting thermometer is a “one-piece” thermometer, Takagi teaches the press fitting of the two cases to form the housing. The inner and outer cases are separate and formed from separate pieces of plastic is separate molding processes that do not interfere with one another. Likewise, Pallanes teaches the construction of a shade in which a clear insert is placed in an opaque or translucent outer shade portion. Pallanes does not add any disclosure to Takagi that would help suggest that a unitary housing be made from a single piece of transparent material.

Therefore, it is respectfully submitted that claim 53, as amended is patentable over the cited combination, and that the instant rejection under 35 U.S.C. 112 has been overcome.



In view of the amendments and remarks made herein, applicant respectfully submits that the instant drawing and claim objections, and claim rejections have been overcome. It is submitted that support for the amendments is present in the specification, drawings, and claims of the application as filed. In the interest of advancing prosecution of the application, the Examiner is invited to contact the below-signed representative by telephone to discuss any issues that may remain.


If there are any shortages, the Examiner is authorized to charge our Deposit Account Number 04-0822.

Respectfully submitted,

DERGOSITS & NOAH LLP

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By:

  
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